

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS R. PUZAK,
ALLAN M. HARTSTEIN, MARK CHARNEY,
DAINEL A. PRENER, and PETER H. ODEN

Appeal 2007-0805
Application 09/458,883
Technology Center 2100

Decided: September 7, 2007

Before JOSEPH F. RUGGIERO, LANCE LEONARD BARRY,
and JEAN R. HOMERE, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

ORDER REQUIRING APPELLANTS TO BRIEF AN
ADDITIONAL MATTER

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1, 3-12, and 14-22. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

II. LEGAL PRINCIPLES

At the time the Appellants filed their Appeal Brief, such a brief was required to include "[a] concise explanation of the invention defined in the claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing . . . by reference characters." 37 C.F.R. § 1.192(c)(5)(2002).¹ "[R]eference to page and line number of the specification . . . is [always] considered important to enable the Board to more quickly determine where the claimed subject matter is described in the application." M.P.E.P. § 1206 (8th ed. Aug. 2001).²

III. ANALYSIS

Here, the Appellants' *Summary of Invention* refers to "page 7" of their Specification. (Br. 3.) That page, however, does not describe the claimed subject matter. Instead, it described "Related Art." (*Id.* 1.) Furthermore, the

¹ We cite to the version of the Code of Federal Regulations in effect at the time of the Appeal Brief. The current requirements for a summary of claimed subject matter are set forth in 37 C.F.R. § 41.37(c)(1)(iv) and are more demanding than those of § 1.192(c)(5)(2002).

² We cite to the version of the M.P.E.P. in effect at the time of the Appeal Brief. This explanation is repeated in M.P.E.P. § 1205.02 (8th ed., rev. 5 Aug 2006).

Summary of Invention refers to specific line numbers of the Specification. (*Id.*) Although such precision is welcome, the Specification itself omits line numbers.

We decline to substitute speculation about the referenced parts of the Specification for the greater certainty that should come from the Appellants' (1) referring to pages and line numbers of the Specification that describe their claimed subject matter and (2) furnishing of a copy of the referenced pages of the Specification with line numbers.

Any additional Brief submitted by the Appellants should be self-contained with respect to all arguments. No prior Briefs should be referenced or incorporated therein. Furthermore, any Answer submitted by the Examiner should be self-contained with respect to all rejections and arguments; no prior Answer or Office action should be referenced or incorporated therein.

IV. CONCLUSION

Under 37 C.F.R. § 41.50(d), the Appellants are given a non-extendable time period of thirty days within which to respond to this order. Failure to comply with the order within that time may result in the *sua sponte* dismissal of their appeal. 37 C.F.R. § 41.50(d). No time for

Appeal 2007-0805
Application 09/458,883

taking any action connected with this appeal may be extended under 37
C.F.R. § 1.136(a)(1)(iv).

ORDERED

KIS

JAY P. SBROLLINI
IBM CORPORATION
INTELLECTUAL PROPERTY LAW DEPT
PO BOX 218
YORKTOWN NY 10598